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With regard to reissue Claims 20-23 and the limitation "displacement-type flow," the examiner states that the applicant has surrendered claims to subject matter which does not include the limitations "downwardly directed" and "toward the threads of the warp" of original Claim 1, because these limitations were argued by the applicant as giving patentability to Claim 1 during prosecution of the original patent. The examiner cites the case of Hester Industries v. Stein Inc., 46 U.S.P.Q.2d 1641, 1649 (Fed. Cir. 1998), and Applicant's arguments made during original prosecution to define over the prior art "Report" discussed on page 7 of the amendment filed August 17, 1994.

As an initial matter, the facts of Hester are easily distinguished from those of the present case. In Hester, the applicant repeatedly argued during prosecution of the original patent that certain limitations distinguished the original claims from the prior art, and that each of these limitations was critical to patentability. For this reason, the recapture rule was applied to prevent the applicant from obtaining allowable claims in the reissue case which did not include these admittedly "critical" limitations.

In the present case, the limitations "downwardly directed" and "towards the threads of the warp" were clearly not critical to patentability of the original claims, but instead were limitations merely incidental to the distinguishing feature of the invention—the *displacement type flow*. Taken in proper context, the applicant's arguments in the August 17, 1994 amendment fully support this point. Specifically, the applicant argued:

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*claim 1...recites the step of distributing the conditioning air stream so as to form a downwardly directed piston-type displacement flow towards threads of the warp. The above mentioned Report does not teach or suggest such a distribution step. The Report merely discloses a local air outlet which is directly vertically from above onto the back shed. [Emphasis in original text]*

Applicant Amendment, August 17, 1994 at p. 7.

The weight of this argument clearly relates to the step of distributing the conditioned air stream in a piston-type displacement flow. Furthermore, in this discussion, the applicant expressly acknowledges the prior art's disclosure of a local air outlet directed vertically from above onto the back of the shed. Given this disclosure in the prior art, the limitations "downwardly directed" and "towards the threads of the warp" were certainly not argued by the applicant as being critical to patentability, nor could they have been.

The prosecution history of the original patent further supports the "non-criticality" of these limitations. On two separate occasions, the examiner stated unequivocally that the only limitation that distinguished original Claim 1 from the prior art cited was the displacement-type (piston) flow. See Office Actions dated April 19, 1994 at p. 3, and September 9, 1994 at p. 2. However, because the examiner initially viewed this feature as a *structural limitation* in a method claim, it was not given sufficient weight to distinguish the claim from the prior art "Report" mentioned above. Applicant clarified the meaning of this limitation in its amendment dated February 7, 1995 at p. 6 by stating:

It appears that the examiner has misunderstood the concept of 'piston-type' flow. This is not structure, but rather a type of air flow. Claim 1 has been amended to replace the term 'piston-type' with 'displacement-type' air flow to eliminate any confusion. 'Displacement-type' air flow is a non-turbulent, or laminar flow, over the full cross-section of the flow. As disclosed in the specification at page 7, lines 2-20, a stepwise distribution of air is provided

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such that the displacement air flow is directed towards threads of the warp. [Emphasis in original text]

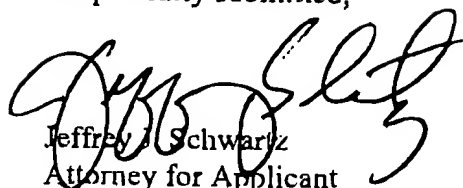
After receiving this explanation, no further art rejection was made by the examiner. The fact that the flow is stated as being *downwardly directed* and *towards threads of the warp* in original Claim 1 is clearly incidental in view of the art cited. Instead, the distinguishing feature, as properly noted by the examiner, is the displacement-type flow which is a non-turbulent, or laminar flow, over the full cross-section of the flow.

Unlike the critical limitations discussed in Hester, the limitations "downwardly directed" and "towards the threads of the warp" are *not* critical limitations, nor were they argued as such during prosecution of the original patent. For this reason, the holding in Hester does not invoke application of the recapture rule in this case. The weight of all argument made by the applicant to distinguish the prior art clearly relates to the "displacement-type flow" and its non-turbulent, laminar flow characteristics. Likewise, nowhere in the original prosecution does the examiner indicate that the limitations "downwardly directly" or "towards the threads of the warp" are relevant, much less critical, to patentability.

For all of the reasons discussed above, Applicant submits that all of the claims in the case are now in condition for allowance. Such action is therefore requested at an early date. If the examiner believes that issues remain for discussion, he is invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

  
Jeffrey J. Schwartz  
Attorney for Applicant  
Registration No. 37,532

Jeffrey J. Schwartz  
Adams Law Firm, P.A.  
2180 First Union Plaza  
Charlotte, North Carolina 28282  
Tel.: (704) 375-9249  
Fax: (704) 375-0729  
e-mail: [jjjs@adamspat.com](mailto:jjjs@adamspat.com)